

Remarks

Reconsideration of the application is requested.

Claims 1-40 have been rejected. No claims have been amended or cancelled. Accordingly, Claims 1-40 remain pending in the application.

Applicant appreciatively acknowledges the Examiner's withdrawal of the Chang and Cook references as grounds for a 35 U.S.C. § 103(a) rejection, and the Examiner's consideration of Applicant's arguments submitted in the response dated August 8, 2005.

Claim Rejections – 35 U.S.C. § 103

To establish obviousness under 35 U.S.C. § 103, the Examiner must view the invention as a whole. Further, the Examiner is to perform the obviousness analysis in accordance with the standard set forth by the Supreme Court in *Graham v. John Deere Co.* That standard requires that the Examiner (1) determine the scope and content of the prior art; (2) ascertain the differences between the prior art and the claims in issue; (3) resolve the level of ordinary skill in the art; and (4) evaluate evidence of secondary considerations. 383 U.S. 1, 17-18 (1966); *see also* MPEP 2141. Secondary considerations include whether the invention met with commercial success, whether the invention answered a long felt need, and whether others attempting the invention have failed. *Graham*, 383 U.S. at 17-18. Further, in applying the *Graham* framework, the Examiner must consider the invention as a whole, without the benefit of hindsight. MPEP 2141.

1. In "Claim Rejections – 35 USC § 103," on page 2 of the above-identified Office Action, claims 1-3, 5-15, 18-23, 25-35, and 38-40 have been rejected as being unpatentable over U.S. Patent Publication No. 2002/0059565 to *Reyna et al.* (hereinafter "Reyna") in view of U.S. Patent Publication No. 2002/0046349 to *Burgin et al.* (hereinafter "Burgin") under 35 U.S.C. § 103(a).

Claim 1 requires:

“processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application; and

generating by the computing device a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays, to enable viewing of said contents of said binary file without usage of said source application, by rendering said one or more user interface displays in accordance with said one or more specifications.”

In contrast, Burgin merely teaches a method of generating a self-contained executable program that can be attached to an email. The executable contains both pictures and instructions to the recipient computer on how to view such pictures, the executable referred to by Burgin as an “album.” Even assuming *arguendo* that the self-contained representation of Burgin reads on that of the present invention as claimed in claim 1, Burgin still fails to disclose, expressly or inherently, “one or more specifications correspondingly specifying the one or more user interface displays.” As claimed in claim 1, each user interface display must have a corresponding specification. No such teaching is inherent in Burgin. The self-contained representation of Burgin may be practiced with one “specification” defining all of the user interface displays. Thus, specifications correspondingly specifying user interface displays are neither expressly nor inherently disclosed by Burgin.

Reyna does not remedy the deficiencies of Burgin. As the Examiner has noted, Reyna does not teach a self-contained representation, much less a self-contained representation that includes specifications correspondingly specifying user interface displays. Rather, Reyna discloses a method and apparatus for generating an output file that can be used on any sort of computing platform with any sort of user interface, in conjunction with a software application. The output file is generated by compiling a code generation file of a lowest common denominator programming language with a formatted/modified data file expressing data of a raw input data file in some platform independent formatting language such as XML, ASCII, or

binary. The only binary file expressly or inherently disclosed by Reyna as being processed is a formatted/modified data file. The raw data file of Reyna is neither expressly nor inherently taught to be a binary file. Further, Reyna does not teach the processing of the formatted/modified data file to identify user interfaces displays. Consequently, Reyna does not disclose, expressly or inherently, “processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application.”

Therefore, for at least the foregoing reasons, Reyna and Burgin, individually or in combination, do not suggest claim 1.

Each of independent claims 7, 15, 21, 27, and 35 contain in substance the same recitations earlier discussed for claim 1. Accordingly, for at least the same reasons, claims 7, 15, 21, 27, and 35 are patentable over Reyna and Burgin.

Claims 3, 5-6, 8-11, 13-14, 18-19, 23, 25-26, 28-31, 33-34, and 38-39 depend from claims 1, 7, 15, 21, 27, and 35 respectively. Thus, for at least the same reasons, claims 3, 5-6, 8-11, 13-14, 18-19, 23, 25-26, 28-31, 33-34, and 38-39 are patentable over Reyna and Burgin.

2. In “Claim Rejections – 35 USC § 103,” on page 9 of the above-identified final Office Action, claims 4, 16-17, 24, and 36-37 have been rejected as being unpatentable over Reyna and Burgin, as applied to claim 1, and further in view of U.S. Patent No. 6,014,688 to *Venkatraman et al.* (hereinafter “Venkatraman”) under 35 U.S.C. § 103(a).

As stated above, Reyna and Burgin, individually or combined, fail to disclose required, recited operations of the present invention, as claimed in claims 1, 15, 21, and 35. Thus, even when combined with Venkatraman, the cited art fails to show novel features that are noted when the invention of claims 1, 15, 21, and 35 is viewed as a whole. Claims 4, 16-17, 24, and 36-37 depend from claims 1, 15, 21, and 35. Consequently, claims 4, 16-17, 24, and 36-37 are patentable over the combination of Reyna, Burgin, and Venkatraman.



Conclusion

In view of the foregoing, reconsideration and allowance of claims 1-40 are solicited. Applicant submits that claims 1-40 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1513. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,

SCHWABE, WILLIAMSON & WYATT, P.C.

Robert C. Peck
Reg No. 56,826

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Schwabe, Williamson & Wyatt, P.C.
Pacwest Center, Suites 1600-1900
1211 SW Fifth Avenue
Portland, Oregon 97204
Telephone: 503-222-9981